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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,409	10/30/2001	Kenneth J. Wilson	1521-251US	8743

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EXAMINER
TAYLOR, NICHOLAS R

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/020,409	WILSON, KENNETH J.
	Examiner	Art Unit	
	Nicholas R. Taylor	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 October 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-5,8,9,15-18 and 20-27* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-5,8,9,15-18 and 20-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>20 April 2005</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1. Claims 3-5, 8, 9, 15-18 and 20-27 have been presented for examination and are

rejected.

Response to Arguments

2. Applicant's arguments filed 10/06/2005 with respect to claim 3-5, 8, 9, 15-18 and

20-27 have been considered but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b),
> by another filed in the United States before the invention by the applicant for patent or (2) a
> patent granted on an application for patent by another filed in the United States before the
> invention by the applicant for patent, except that an international application filed under the treaty
> defined in section 351(a) shall have the effects for purposes of this subsection of an application
> filed in the United States only if the international application designated the United States and
> was published under Article 21(2) of such treaty in the English language.

4. Claims 3, 9, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by

Tyroler (US Patent 6,320,941).

5. As per claim 21, Tyroler teaches in an e-mail server having an annunciator and a

visible counter affixed thereto, a method for alerting a user to the receipt in the e-mail

server of an e-mail message comprising the steps of:

receiving the e-mail message in the server; (Tyroler, column 3, lines 40-49)

storing the e-mail message in a mailbox corresponding to the user; (Tyroler, column 5, lines 30-35)

altering a count in the counter to correspond with the number of e-mail messages stored in the user's mailbox; (Tyroler, column 5, lines 18-26)

scanning the e-mail message stored in the mailbox to determine if a text string within the e-mail message meets a predetermined outcome criteria; and (Tyroler, column 5, lines 7-25)

activating the annunciator to emit an acoustic or a light signal if the text string meets the predetermined outcome criteria (Tyroler, column 5, lines 39-46).

6.   As per claim 3, Tyroler teaches the system further wherein the text string comprises a "from" address (Tyroler, column 5, lines 7-25).

7.   As per claim 9, Tyroler teaches the system further including the step of the server receiving a description of the predetermined outcome criteria from the at least one computer (Tyroler, column 3, lines 5-19).

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 4, 5, 8, 15-18, 20, and 22-27 rejected under 35 U.S.C. 103(a) as being unpatentable over Tyroler (US Patent 6,320,941) and Koch et al. (US PGPub 2003/0061290).

10.   As per claim 4, Tyroler teaches the above including wherein the text string comprises a "from" address (Tyroler, column 5, lines 7-25) yet fails to teach wherein the text string includes a text string other than the "from" address.

Koch teaches a method for notifying users of the receipt of email (Koch, paragraph 0013) where the outcome criteria and instructions (Koch, paragraph 0017) for the notifications are configured via a web page interface (Koch, paragraphs 0041-0042). Koch also teaches forwarding messages (Koch, paragraphs 0027-0029) and various filters including urgent flags (Koch, paragraph 0017).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Tyroler and Koch to provide the configuration system of Koch in the system of Tyroler, because doing so would allow users to check their email, using specific outcome instructions, without requiring access to a computer on the communication network (Koch, paragraph 0005).

11.   As per claim 5, Tyroler teaches the above including wherein the text string comprises a "from" address (Tyroler, column 5, lines 7-25) yet fails to teach wherein there exists an "urgent" flag.

Koch teaches a method for notifying users of the receipt of email (Koch, paragraph 0013) where the outcome criteria and instructions (Koch, paragraph 0017) for the notifications are configured via a web page interface (Koch, paragraphs 0041-0042). Koch also teaches forwarding messages (Koch, paragraphs 0027-0029) and various filters including urgent flags (Koch, paragraph 0017).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Tyroler and Koch to provide the configuration system of Koch in the system of Tyroler, because doing so would allow users to check their email, using specific outcome instructions, without requiring access to a computer on the communication network (Koch, paragraph 0005).

12. As per claim 8, Tyroler teaches the above yet fails to teach further including the step of forwarding the message to an addressee.

Koch teaches a method for notifying users of the receipt of email (Koch, paragraph 0013) where the outcome criteria and instructions (Koch, paragraph 0017) for the notifications are configured via a web page interface (Koch, paragraphs 0041-0042). Koch also teaches forwarding messages (Koch, paragraphs 0027-0029) and various filters including urgent flags (Koch, paragraph 0017).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Tyroler and Koch to provide the configuration system of Koch in the system of Tyroler, because doing so would allow users to check

their email, using specific outcome instructions, without requiring access to a computer

on the communication network (Koch, paragraph 0005).

13.   As per claim 22, Tyroler teaches an e-mail server in a housing comprising:

a memory having a first region for storing computer executable program code

and a second region corresponding to a user mailbox; (Tyroler, figure 1, items 14 and

16)

an annunciator and a visible counter, each of which is affixed to the housing; and

(Tyroler, column 5, lines 39-46)

a processor for executing the program code stored in said memory, wherein the

program code includes: (Tyroler, figure 1, item 12)

code for processing a received e-mail message including:

code for storing the received e-mail message in the user's mailbox;

(Tyroler, column 5, lines 30-35)

code for altering a count in the counter to correspond with the

number of e-mail messages stored in the mailbox; (Tyroler, column 5, lines 18-26)

code for scanning the e-mail message stored in the user mailbox to

determine if a text string within the e-mail message meets one of the outcome criteria;

and (Tyroler, column 5, lines 7-25)

code for activating the annunciator (Tyroler, column 5, lines 39-46).

However, Tyroler teaches configuring the server via a client machine (Tyroler,

figure 1, PC item 24) yet fails to teach

code for configuring the e-mail server, including code for generating a web page which accepts at least one outcome criteria and at least one outcome instruction.

Koch teaches a method for notifying users of the receipt of email (Koch, paragraph 0013) where the outcome criteria and instructions (Koch, paragraph 0017) for the notifications are configured via a web page interface (Koch, paragraphs 0041-0042). Koch also teaches forwarding messages (Koch, paragraphs 0027-0029) and various filters including urgent flags (Koch, paragraph 0017).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Tyroler and Koch to provide the configuration system of Koch in the system of Tyroler, because doing so would allow users to check their email, using specific outcome instructions, without requiring access to a computer on the communication network (Koch, paragraph 0005).

14.   As per claim 23, Tyroler-Koch teaches the system further wherein the e-mail server receives a description of the predetermined outcome criteria from a client computer (Tyroler, column 3, lines 5-19).

15.   As per claim 24, Tyroler-Koch teaches the system further wherein the annunciator provides a visual alert (Tyroler, column 5, lines 39-46).

16.   As per claim 25, Tyroler-Koch teaches the system further wherein the annunciator provides an audio alert (Tyroler, column 5, lines 60-64).

17.   As per claim 27, Tyroler-Koch teaches the system further including code for determining whether an output of the annunciator should be steady or interrupted (Tyroler, column 5, lines 8-25 and 38-56).

18.   As per claim 15, Tyroler teaches an email server having an attached annunciator (Tyroler, column 3, lines 40-49; column 5, lines 39-46) yet fails to teach the method comprising:

generating a web page which accepts the outcome criteria and the outcome instructions including an outcome instruction for activating the attached annunciator;

entering at least one of the outcome criteria and at least one of the outcome instructions into the web page; and

submitting the at least one outcome criteria and the at least out outcome instruction to the e-mail server.

Koch teaches a method for notifying users of the receipt of email (Koch, paragraph 0013) where the outcome criteria and instructions (Koch, paragraph 0017) for the notifications are configured via a web page interface (Koch, paragraphs 0041-0042). Koch also teaches forwarding messages (Koch, paragraphs 0027-0029) and various filters including urgent flags (Koch, paragraph 0017).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Tyroler and Koch to provide the configuration system of Koch in the system of Tyroler, because doing so would allow users to check

their email, using specific outcome instructions, without requiring access to a computer

on the communication network (Koch, paragraph 0005).

19.   As per claim 16, Tyroler-Koch teaches the system further wherein the outcome

criteria comprises a "from" address (Tyroler, column 5, lines 7-25).

20.   As per claim 17, Tyroler-Koch teaches the system further wherein the outcome

criteria includes a text string (Tyroler, column 5, lines 7-25).

21.   As per claim 18, Tyroler-Koch teaches the system further wherein the outcome

criteria includes an "urgent" flag (Koch, paragraph 0017).

22.   As per claim 20, Tyroler-Koch teaches the system further wherein the outcome

instructions include the address of an addressee for receiving the e-mail message

(Koch, paragraphs 0027-0029).

23.   As per claim 26, Tyroler-Koch teaches the system further wherein the instruction

for activating the annunciator provides for the annunciator output to be steady or

interrupted (Tyroler, column 5, lines 8-25 and 38-56).

Conclusion

24.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Taylor whose telephone number is (571) 272-3889. The examiner can normally be reached on Monday-Friday, 8:00am to 5:30pm, with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.   Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas Taylor
Examiner
Art Unit 2141

RUPAL DHARIA